

held that all the limitations of the claimed invention are either inherent or disclosed in the *Bedford et al.* reference.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131 quoting Verolegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants respectfully assert that the *Bedford et al.* reference does not teach the claimed substantially wrap-free pressing of the mixed particles into the rolled linoleum sheet. *Bedford et al.* does not teach a substantially wrap-free pressing as claimed in the present application, but actually teaches away from a substantially wrap-free pressing by teaching the use of a wrapped press. *Bedford et al.* teaches that a printed tissue containing the pigmented pattern is laid face side down upon the linoleum substrate and the two are carried forward around the lower half of a heated metal roller supplied with a stout linoleum apron or ban capable of being adjusted so that as to bring pressure to bear upon the cloth and tissue passing between it and the roller. Column 2, lines 75-80. The printed pattern or particles are pressed into the linoleum substrate as they are wrapped around metal roller constrained by a strap. Thus, *Bedford et al.* fails to teach or suggest the limitation found in claim 1 of substantially wrap-free pressing of the mixed particles. The remaining claims 3-6, 8-13, and 16-18 all either depend directly or indirectly from claim 1, and are thus asserted to be novel and nonobvious over the cited art.

Claims 7 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bedford et al.* in view of U.S. Patent No. 5,571,588 to *Lusi et al.* *Bedford et al.* is said by the PTO to disclose all that is claimed except for the particles being applied to both sides of the linoleum and that the particles are present in an amount of between 10-500 g/m². However, the PTO states that *Lusi et al.* discloses a durable inlaid floor covering wherein the

particles may be deposited under the underlying area and subsequently embedded using a drum provided with a pressure belt and the particles being placed in a density of between about 223 to 264 g/m².

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1584, 3 U.S.P.Q.2d 1436, 1439 (Fed. Cir. 1987). Initially, the PTO bears the burden of establishing the *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984).). To support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the [PTO] must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*


Applicants respectfully assert that one of ordinary skill in the art would not combine that which is taught in *Lusi et al.* with that in *Bedford et al.* *Lusi et al.* teaches that embedding of the mixed mass particles into the linoleum sheet using a wrapped pressing method as stated by the PTO. The present application claims a substantially wrap-free pressing of the mixed mass particles into the rolled linoleum sheet. Thus, *Lusi et al.* teaches away from that which is claimed in the present application. Additionally, *Bedford et al.* also teaches a wrapped pressing method. Thus, one of ordinary skill in the art would not be motivated to combine that which is taught in *Lusi et al.* with that taught in *Bedford et al.* since neither teaches a substantially wrap-free pressing of the particles as claimed in the present application. Furthermore, the cited art teaches away from the claimed substantially wrap-free process by teaching a wrapped process.

Furthermore, claim 2 is said to be rejected by the PTO under 35 U.S.C. § 103(a) as being unpatentable over *Bedford et al.* in view of Applicants' own admission. The PTO states that Applicants admit on page 2 that the process of producing marbled structures is known and comprises the steps of dividing the linoleum into pieces, arranged scale-like in the form of a multi-layered sheet stack wherein the sheet stack is fed into the nip of a calendar and rolled to the desired thickness. Applicants respectfully contend that since *Bedford et al.* does not teach or suggest substantial wrap-free pressing of the mixed particles into the rolled linoleum sheet as claimed in the present application, one skilled in the art would not be motivated to combined the wrapped process taught in *Bedford et al.* with any marbling process as disclosed.

Thus, Applicants respectfully submit that claims 1-14 and 16-18 of the application are believed to be in a condition for allowance and an early notice to such effect is earnestly solicited.

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Date

Respectfully submitted,


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